

## **REMARKS**

### **I. PRELIMINARY REMARKS**

No claims have been amended. Non-elected claims 23-37 have been canceled. Claims 47-52 have been added. Claims 1-22 and 38-52 remain in the application. Claims 9, 12, 19, 21, 23, 44 and 46 have been withdrawn from consideration. Reexamination and reconsideration of the application, as amended, are respectfully requested.

### **II. PRIOR ART REJECTIONS**

#### **A. The Rejections**

Claims 1-6, 8, 11, 13-16, 18, 22, 38-41, 43 and 45 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of U.S. Patent No. 6,692,491 to Phan ("the Phan '491 patent"), U.S. Patent No. 6,277,117 to Tetzlaff ("the Tetzlaff '117 patent"), and U.S. Patent No. 6,115,626 to Whayne ("the Whayne '626 patent"). Claims 7, 17 and 42 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Phan '491 patent, the Tetzlaff '117 patent, the Whayne '626 patent and U.S. Patent No. 6,771,996 to Bowe ("the Bowe '996 patent"). Claims 10 and 20 have been rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of the Phan '491 patent, the Tetzlaff '117 patent, the Whayne '626 patent, and U.S. Patent No. 6,997,925 to Maguire ("the Maguire '925 patent").

The rejections under 35 U.S.C. § 103 are respectfully traversed. Reconsideration thereof is respectfully requested.

**B. Discussion Concerning Claims 1-6, 8, 11, 13-16, 18, 22, 38-41, 43 and 45**

Independent claim 1 calls for a combination of elements including, *inter alia*, “a support device,” “a coagulation element carried by the support device” and “a stimulation element carried by the support device.” Independent claims 14 and 38 call for respective combinations of elements including, *inter alia*, “a clamp including a first clamp member [and] a second clamp member,” “a coagulation element associated with one of the first and second clamp members” and “a stimulation element associated with one of the first and second clamp members.” The respective combinations defined by claims 2-6, 8, 11 and 13 include, *inter alia*, the elements recited in claim 1, the respective combinations defined by claims 15, 16, 18 and 22 include, *inter alia*, the elements recited in claim 14, and the respective combinations defined by claims 39-41, 43 and 45 include, *inter alia*, the elements recited in claim 38.

The cited references fail to teach or suggest the claimed combinations. For example, and as tacitly admitted in the Office Action, the Phan ‘491 and Tetzlaff ‘117 patents fail to suggest the use of “a coagulation element” and “a stimulation element” that are both carried on a support device that is configured to be removably secured to a clamp member. The Phan ‘491 and Tetzlaff ‘117 patents also fail to suggest the use of “a coagulation element” and “a stimulation element” that are both associated with a clamp. To the contrary, the Phan ‘491 and Tetzlaff ‘117 patents merely disclose the use of coagulation elements that are secured, either permanently or removably, to a clamp.

The Whyne patent fails to remedy this deficiency. The Whyne patent is directed to a system that includes an instrument 12, with an array of mapping electrodes 18, and a pair of **separate** “roving” instruments 14 and 16. Each “roving” instrument may be used to perform one of the imaging, sensing or therapeutic functions discussed in column 4, lines 9-23. As such, the Whyne patent would not have suggested adding a stimulation element to a support device configured to be secured to a clamp member, or to a clamp, that itself includes a coagulation element.

As the Phan ‘491, Tetzlaff ‘117, and Whyne ‘626 patents fail to establish a *prima facie* case of obviousness with respect to the respective combinations of elements recited

in independent claims 1, 14 and 38, applicant respectfully submits that the rejection of claims 1-6, 8, 11, 13-16, 18, 22, 38-41, 43 and 45 under 35 U.S.C. § 103 should be withdrawn.

**C. Discussion Concerning Claims 7, 17 and 42**

Applicant respectfully submits that the Bowe '996 patent, which has been cited for its purported teachings concerning coagulation and stimulation element lengths, fails to remedy the aforementioned deficiencies in the Phan '491, Tetzlaff '117, and Whayne '626 patents. As such, claims 7, 17 and 42 are patentable for at least the same reasons as claims 1, 14 and 38 and the rejection of claims 7, 17 and 42 under 35 U.S.C. § 103 should also be withdrawn.

**D. Discussion Concerning Claims 10 and 20**

Applicant respectfully submits that the Maguire '925 patent, which has been cited for its purported "separate wire" teachings, fails to remedy the aforementioned deficiencies in the Phan '491, Tetzlaff '117, and Whayne '626 patents. As such, claims 10 and 20 are patentable for at least the same reasons as claims 1 and 14 and the rejection of claims 10 and 20 under 35 U.S.C. § 103 should also be withdrawn.

**III. NEWLY PRESENTED CLAIMS 47-52**

Newly presented independent claim 47 calls for a combination of elements comprising "a support device configured to be removably secured to at least one of the first and second clamp members," "means, carried by the support device, for transmitting coagulation energy to tissue" and "means, carried by the support device, for transmitting stimulation energy to tissue." Applicant respectfully submits that the references cited in the Office Action fail to teach or suggest such a combination and that claims 47-52 are patentable thereover.

#### IV. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,

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